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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,964	04/07/2006	Eiji Kato	81864.0070	8731
26/021 7590 10/06/2008 HOGAN & HARTSON LLP. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067				
EXAMINER				
SHEEHAN, JOHN P				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
10/06/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,964

Applicant(s)

KATO ET AL.

Examiner

John P. Sheehan

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date ____

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 to 9, drawn to a sintered rare earth permanent magnet comprising a main phase comprising $R_2T_{14}B$ compounds and a grain boundary phase having a higher amount of rare earth than the main phase which is characterized in that said sintered rare earth permanent magnet satisfies the following formulas:

$$AVE(X)/Y = 0.8 \text{ to } 1.0; \text{ and}$$

$$(X/Y)_{\max}/(X/Y)_{\min} = 2.0 \text{ to } 13.0,$$

wherein X represents (the weight ratio of heavy rare earth elements)/(the weight ratio of all the rare earth elements) for a given number of said main phase grains in said sintered body;

Y represents (the weight ratio of heavy rare earth elements)/(the weight ratio of all the rare earth elements) for said sintered body as a whole;

AVE(X) represents the mean value of X obtained for the given number of said main phase grains;

(X/Y)_{min} represents the minimum value of (X/Y) obtained for the given number of said main phase grains; and

(X/Y)_{max} represents the maximum value of (X/Y) obtained for the given number of said main phase grains.

Group II, claim(s) 10 to 15, drawn to a method of making a sintered rare earth permanent magnet which comprises a sintered body comprising at least main phase grains comprising $R_2T_{14}B$ and a grain boundary phase having a higher amount of R than said main phase grains, wherein said sintered body comprises heavy rare earth elements as R, which is characterized in that the method comprises the steps of:

compacting, in a magnetic field, a low R alloy powder mainly comprising an $R_2T_{14}B$ phase, and a high R alloy powder having a higher amount of R than said low R alloy powder and comprising Dy and/or Tb as such R, and

sintering the compacted body obtained by said compacting in a magnetic field step,

wherein said high R alloy powder contains 30 wt% or more of heavy rare earth elements contained in said sintered body.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

3. In the Group I invention the special technical feature is that the sintered rare earth permanent magnet satisfies the following formulas:

$$AVE(X)/Y = 0.8 \text{ to } 1.0; \text{ and}$$

$$(X/Y)_{\max}/(X/Y)_{\min} = 2.0 \text{ to } 13.0,$$

wherein X represents (the weight ratio of heavy rare earth elements)/(the weight ratio of all the rare earth elements) for a given number of said main phase grains in said sintered body;

Y represents (the weight ratio of heavy rare earth elements)/(the weight ratio of all the rare earth elements) for said sintered body as a whole;

AVE(X) represents the mean value of X obtained for the given number of said main phase grains;

(X/Y)_{min} represents the minimum value of (X/Y) obtained for the given number of said main phase grains; and

(X/Y)_{max} represents the maximum value of (X/Y) obtained for the given number of said main phase grains.

4. In the Group II invention the special technical feature is that the method comprises the steps of:

compacting, in a magnetic field, a low R alloy powder mainly comprising an $R_2T_{14}B$ phase, and a high R alloy powder having a higher amount of R than said low R alloy powder and comprising Dy and/or Tb as such R, and

sintering the compacted body obtained by said compacting in a magnetic field step,

wherein said high R alloy powder contains 30 wt% or more of heavy rare earth elements contained in said sintered body.

5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

6. The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (7:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Sheehan/
Primary Examiner, Art Unit 1793

JPS